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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/253,638	02/19/1999	KEISUKE OGURO	1217-990257	5855

7590

06/03/2003

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EXAMINER

ZITOMER, FRED

ART UNIT

PAPER NUMBER

1713

DATE MAILED: 06/03/2003

24

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/253,638

Applicant(s)

OGURO ET AL.

Examiner

Fred Zitomer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 May 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 8-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 8-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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1.

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 2, 2003 has been entered.

2.

This responds to the communication of May 2, 2003. The rejection of record under 35 U.S.C. 103(a) over Shahinpoor et al, WO 97/26039, alone or taken with Nidola et al. is maintained and extended to new claims 10-12 as stated below. No claim is allowed.

3.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4.

Claims 1 and 8-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shahinpoor et al, WO 97/26039, alone or taken with Nidola et al., US 4364,803.

Shahinpoor teaches preparing polymeric actuators by conducting present steps (i) to (iii) [page 3, line 24 - page 7, line 18]. The options of changing the order and/or repeating steps corresponding to present steps (ii) to (iii) are disclosed [see e.g. page 7, lines 12-13; page 6, lines 8-11; page 5, lines 6-30; claim 82]. Nidola teaches controlling the amount of metal deposited on the surface of ion exchange resins during reductive deposition, i.e. present step (i), by repeating

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the step of adsorbing metal complexes [Abstract, paragraph 3; column 5, lines 1-14; Example 1]. Shahinpoor differs from the instant invention by not disclosing that the step of adsorbing metal complexes can be repeated.

It would have been obvious to repeat the step of allowing an ion exchange resin to adsorb a metal complex because it is well settled that a result oriented variable implemented within the skill of the art to solve a known problem in a known process is obvious absent the showing of a new or unexpected result. *In re Boesch*, 205 USPQ 215. In the present case it is generally known to regulate the amount of metal deposited by controlling parameters such as concentration, contact time, temperature, and the number of cycles.

In the alternative, it would have been obvious to control the amount of metal deposited on an ion exchange resin by repeating the metal complex absorption step because Nidola teaches the embodiment for depositing the same metals on the same ion exchange resins as Shahinpoor.

5.

Applicant's arguments filed May 2, 2003 have been fully considered but they are not persuasive. The arguments repeat earlier assertions that the prior art fails to teach depositing metal on the surface and inside the resin product. By way of reply attention is directed to the responses given in prior Office actions. See e.g. Paper No. 21, Paragraph 4.

In sum, applicant admits that the deposition of metal inside the resin product results from repeating the present process steps. Contrary to applicant's assertion both references teach the embodiment as noted above. See e.g. Shahinpoor at page 11, lines 28-29. In this regard it is well settled that if the steps of a process are the same the results must be the same unless the

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difference is due to factors not recited in the claims. *In re Sussman*, 141 F. 2d 267, 60 USPQ 538 (CCPA 1944); *In re Spada* 15 USPQ 1655.

6.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fred Zitomer whose telephone number is (703) 308-2461. The examiner can normally be reached Monday through Friday from 7:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful David Wu can be reached at (703) 308-2450. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 (before final) and (703) 872-9311 (after final).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2351.



FRED ZITOMER, PhD
PRIMARY EXAMINER
ART UNIT 1713

Zitomer/fz
June 2, 2003